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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/810,773

03/26/2004

Jasna Roeth

LEAP:125US

9680

7590

08/29/2006

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,773

Applicant(s)

ROETH ET AL.

Examiner

Arnel C. Lavarias

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2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/3/06, 6/8/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 12-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/8/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The replacement drawings were received on 7/3/06. These drawings are acceptable.

Response to Amendment

2. The amendments to Claims 1, 16, and 20 in the submission dated 7/3/06 are acknowledged and accepted. In view of these amendments, the objections to the claims in Section 10 of the Office Action dated 3/31/06 are respectfully withdrawn.
3. The amendments to the specification of the disclosure in the submission dated 7/3/06 are acknowledged and accepted. In view of these amendments, the objections to the specification in Sections 6-9 of the Office Action dated 3/31/06 are respectfully withdrawn.

Election/Restrictions

4. Newly amended Claim 16, as well as dependent Claims 17-23, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly amended Claim 16, as well as Claims 17-23 which depend on Claim 16, now recites an interchangeable microscope stage drive assembly, including a drive mechanism detachably positionable (as opposed to detachably securable as recited in Claims 1, 4-5,

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8-9) to the microscope stage to more than one location of the stage, which is classifiable in Class 359, subclass 827.

These claims, Claims 1-10, and Claims 12-15, 24-33 are all related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, all of the subcombinations have separate utility in a combination without the particulars of the other subcombinations. See MPEP § 806.05(d).

It is additionally noted that, due to the amendments made to Claim 16, Claim 16 is no longer linking.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for a group is not required for the other groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 16-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

5. The Applicants argue that, with respect to newly amended Claims 1 and 16, as well as Claims 2, 6, 10-11, 23 which depend on Claims 1 and 16, the newly amended claims are now patentably distinct over Claims 1-34 of copending Application No. 10/810979. The Examiner respectfully disagrees. With respect to newly amended Claim 1, copending Application No. 10/810979 specifically claims the microscope stage drive mechanism being detachably secured to the first and second locations (See specifically Claims 1, 5, 7-8, wherein the drive means for the carriage also includes the microscope stage drive mechanism). With regard to Claim 16, copending Application No. 10/810979 specifically discloses the drive mechanism being detachably positionable to the microscope stage to more than one location of the stage (See specifically Claims 1, 7, 8, wherein the drive means for the carriage, and hence the microscope stage drive mechanism, may be detachably secured at at least two locations on the stage.).
6. The Applicants further argue that, with regard to newly amended Claim 1, as well as Claims 2-11 which depend on Claim 1, Stahl et al. fails to teach or reasonably suggest the microscope stage drive mechanism being detachably securable to the first and second locations. After reviewing Stahl et al., the Examiner agrees, and respectfully withdraws the rejections of Claims 1-11 in Sections 14-17 of the Office Action dated 3/31/06. Further arguments regarding Claims 2-11 are noted.
7. Applicants' arguments with regard to Claims 16-23 are moot since these claims have been withdrawn from consideration by original presentation.

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8. Claims 1-11 are now rejected as follows.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-2, 6, 10-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-34 of copending Application No. 10/810979 (U.S. Patent Application Publication US 2005/0111093 A1), of record. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/810979 similarly discloses a microscope stage assembly (See for example Claim 1) comprising a stage (See Claim 1); first engagement means for a microscope stage drive mechanism at a first location on the stage (See Claim 8); and second engagement means for the microscope stage mechanism at a second location on the stage (See Claim 8), wherein the microscope

stage drive mechanism is detachably securable to the first and second locations (See specifically Claims 1, 5, 7-8, wherein the drive means for the carriage also includes the microscope stage drive mechanism); the first and second locations further comprising a rack operatively arranged to engage the microscope stage drive mechanism (See Claims 9, 11); the microscope stage assembly in combination with a microscope (See Claims 18, 24); and the microscope stage assembly in combination with a microscope stage drive mechanism (See Claims 9, 11).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-2, 4, 6, 8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl et al. (U.S. Patent No. 4402576), of record, in view of Kuroha (U.S. Patent No. 4097116).

Stahl et al. discloses a microscope stage assembly (See Figure) comprising a stage (See 10, 11 in Figure); first engagement means for a microscope stage drive mechanism (See for example 21, 23 in Figure) at a first location on the stage (See for example 17 and various screws in Figure); and second engagement means for the microscope stage

mechanism at a second location on the stage (See for example 17 and various screws in Figure). Stahl et al. additionally discloses the first and second locations further comprising a rack operatively arranged to engage the microscope stage drive mechanism (See for example 32, 35 in Figure); the first and second engagement means further comprising a set screw (See for example 17 and various screws in Figure) to detachably secure the stage drive mechanism to the stage; the microscope stage assembly in combination with a microscope (See Figure; Abstract); and the microscope stage assembly in combination with a microscope stage drive mechanism (See 21, 23 in Figure; Abstract). Stahl et al. does not explicitly disclose that the microscope stage mechanism is detachably securable to the first and second locations. However, it is noted that Stahl et al. specifically discloses that attachment of the microscope stage mechanism to the stage is via set screws (See specifically 17 and various screws in Figure) at various locations on the stage, and that the use of such screws to securely attach such microscope stage mechanisms is conventional and well known in the art. As an example, Kuroha similarly teaches a microscope stage assembly (See for example Figure 1) that includes a microscope stage drive mechanism (See 11, 21 in Figures 1-2) securely attached to a microscope stage (See 2 in Figures 1-2) via screws (See various screws in element 6 in Figure 2; col. 2, line 44-col. 3, line 38). Though neither Stahl et al. nor Kuroha explicitly disclose or teach that these screws are detachable so that the microscope stage mechanism is detachably securable to the stage at various locations, one of ordinary skill in the art would recognize that such set screws would be removable from and re-attachable to the microscope stage mechanism and stage at the various locations by mere

use of an appropriate screwdriver. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the microscope stage mechanism, in the microscope stage assembly of Stahl et al. and Kuroha, be detachably securable to the first and second locations, to allow removal of the microscope stage mechanism to allow for repair or replacement of such mechanism when such mechanism is damaged.

13. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl et al. in view of Kuroha as applied to Claim 1 above, and further in view of Kanao (U.S. Patent No. 5802925), of record.

Stahl et al. in view of Kuroha discloses the invention as set forth above in Claim 1, except for the first and second locations further comprising a belt and pulley operatively arranged to engage the microscope stage drive mechanism, so as to effect lateral movement of the slide holder and/or forward and backward movement of the stage. However, the use of belts and pulleys as an alternative means of moving microscope stages and slide holders is known in the art. For example, Kanao teaches a conventional microscope stage (See for example Figures 1-2, 8-9), wherein stage and sample slide movement in both the x (lateral) and y (forward and backward) directions may be effected by either rack and pinion or, more advantageously, belt and pulley (See for example 8, 9a-b, 10a-b, 11 in Figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first and second locations further comprise a belt and pulley operatively arranged to engage the microscope stage drive mechanism, so as to effect lateral movement of the slide holder

and/or forward and backward movement of the stage, as taught by Kanao, in the assembly of Stahl et al. in view of Kuroha, for the purpose of effecting smooth and stable operational movement of the stage without receiving resistance of movement from the stage drive mechanism.

14. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl et al. in view of Kuroha as applied to Claim 1 above, and further in view of Chambers et al. (U.S. Patent No. 3428387), of record.

Stahl et al. in view of Kuroha discloses the invention as set forth above in Claim 1, except for the first and second engagement means further comprising a spring-loaded ball bearing to detachably secure the stage drive mechanism to the stage. However, Chambers et al. teaches a conventional friction driven microscope stage drive mechanism (See for example Figures 2-3), wherein the stage drive mechanism (See 36, 48 in Figure 3) may further include a pressure roller and spring clip (See for example 34, 35 in Figure 3) to maintain engagement with the stage drive mechanism. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first and second engagement means further comprise a spring-loaded ball bearing to detachably secure the stage drive mechanism to the stage, as taught by Chambers et al., in the assembly of Stahl et al. in view of Kuroha, to provide continuous contact with the stage drive mechanism while preventing contact slipping of the stage drive mechanism during use.

Conclusion

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15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arnel C. Lavarias
Primary Examiner
Group Art Unit 2872
8/23/06

Replacement Sheet
U.S. Patent Application No. 10/810,773

5/9

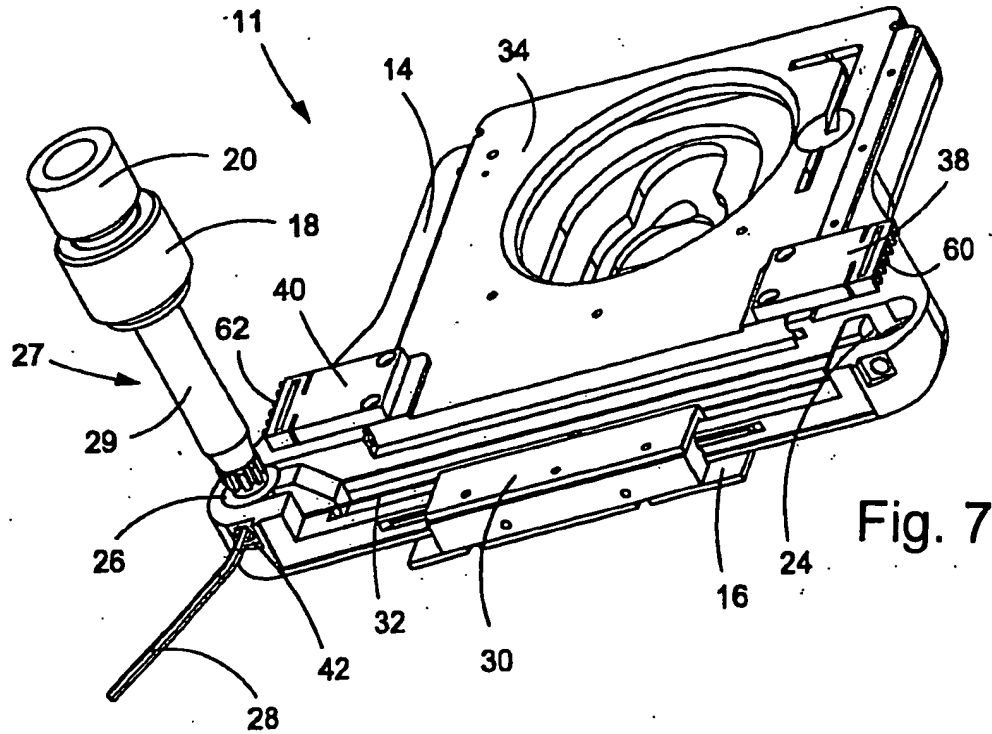


Fig. 7

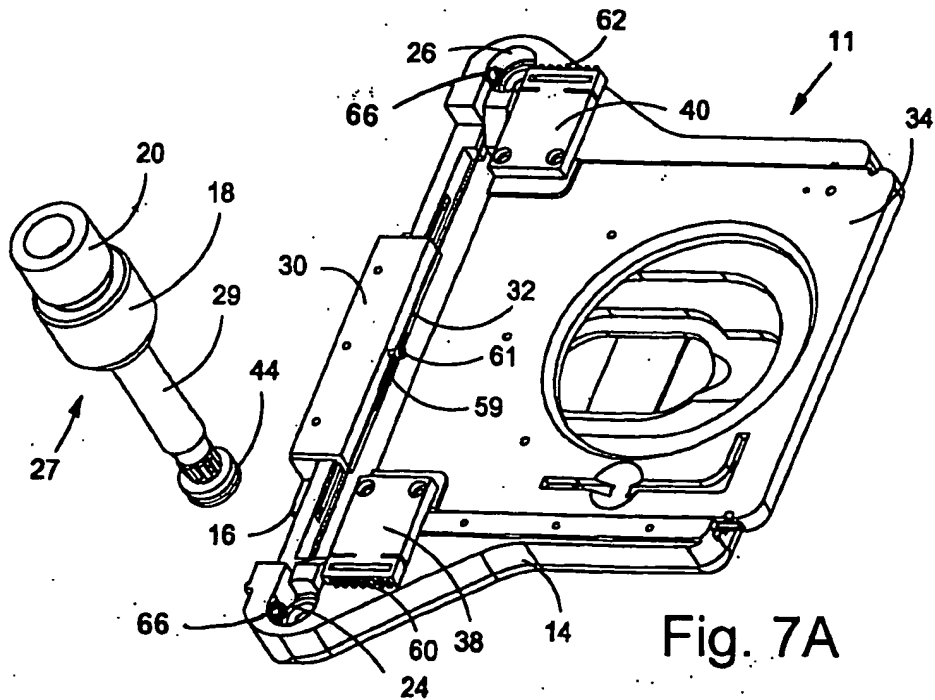


Fig. 7A

Drawing Changes
Approved
acc
8/23/06